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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,659	11/23/2005	Michael John Clarke	D-3212	9880
Frank J Uxa Stout Uxa Buyan & Mullins Suite 300 4 Venture Irvine, CA 92618				
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EXAMINER				
GREENE, JASON M				
ART UNIT		PAPER NUMBER		
1797				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,659

Applicant(s)

CLARKE ET AL.

Examiner

Jason M. Greene

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 10, 12, 14, 15, 35-37 and 39-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36, 37 and 39-46 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 10, 12, 14, 15, 35, 47 and 49-52 is/are rejected.
- 7) ☒ Claim(s) 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Response to Arguments

1. Applicant's arguments, see page 14, lines 1-15, filed 27 October 2008, with respect to 35 USC 102 rejection of claim 37 have been fully considered and are persuasive. The 35 USC 102 rejection of claim 37 has been withdrawn.
2. Applicant's arguments filed 27 October 2008 with respect to the apparatus claims have been fully considered but they are not persuasive. Applicants argue that the Steinwandel et al. reference fails to anticipate the claimed invention since it does comprise means for transporting the gas at a periodically varying flow rates. However, the Examiner maintains his position that the blower of Steinwandel et al. is capable of performing as required by the claim language. Applicants argue that the blower is incapable of having its speed adjusted since such is not explicitly mentioned in the reference. This argument however is not persuasive. While it may be true that the blower does not have a built-in speed control, it would still inherently be capable of operating at varying speeds if the power supplied to it were adjusted, such as by using a common, readily-available in-line speed controller. Thus the blower is capable of

serving as the means for providing a periodically variable flow rate. It appears as though Applicants are attempting to impose functional limitations into apparatus claims.

New claim 48, however, contains allowable subject matter because the prior art does not teach the apparatus of claim 47 wherein the means is a ventilator.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 6, 10, 12, 14, 35, 47 and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Steinwandel et al. (US 5,876,486).

Steinwandel et al. discloses an apparatus capable of separating CO₂ from a gas stream containing CO₂ and an anesthetic gas comprising a gas separation device and means (the blower) for transporting the gas stream at a periodically varying flow rate (by cycling or adjusting the speed of the blower) through the gas separation device, the gas separation device comprising a supported carrier liquid membrane in which the carrier species is an organic base (diethanolamine or monoethanolamine) present at a concentration sufficient to provide a separation factor α of at least 1, and at least 60 for less permeable anesthetic gases, wherein the membrane support is a porous polymer, wherein the membrane is in the form of a bundle of hollow fiber membranes, wherein the apparatus comprises means for generating a sweep gas stream (see Figs. 4 and 5),

and wherein the apparatus comprises a plurality of supported carrier liquid membranes comprising the carrier species, means for transporting a sweep gas past the second membrane, a mass of carrier liquid contacting all the membranes, and means (pump 2') for circulating the carrier liquid past the membranes in Figs. 2-5 and col. 5, line 8 to col. 6, line 58.

With regard to the apparatus being for separating CO₂ from a gas stream containing CO₂ and an anesthetic gas, intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder, 168 USPQ 530 (CCPA 1971). Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, Ex parte Thibault, 164 USPQ 666 (PTO Board of Appeals 1969). Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, In re Otto et al., 136 USPQ 458 (CCPA 1963). A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed, Ex parte Masham, 2 USPQ 2d 1647 (PTO Board of Appeals 1987).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steinwandel et al. (US 5,876,486) in view of Jansen et al. (US 5,749,941).

Steinwandel et al. teaches the carrier being present in a concentration of 2 mol/L, but does not teach a concentration of 4.5 mol/L to 6 mol/L. Jansen et al. discloses a similar apparatus wherein the carrier is present in a concentration of 5 mol/L in col. 5, line 62 to col. 8, line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the higher carrier concentration of Jansen et al. into the apparatus of Steinwandel et al. to increase the capacity of the carrier for transporting the gas, as is well known in the art.

7. Claims 15 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinwandel et al. (US 5,876,486) in view of Sirkar et al. (US 6,635,103 B2).

Steinwandel et al. does not disclose the apparatus comprising means for humidifying the sweep gas stream, but Sirkar et al. '103 teaches a similar apparatus comprising means for humidifying the sweep gas stream in Fig. 1 and col. 2, lines 21-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the sweep gas humidifying means of Sirkar et al. '103 into the apparatus of Steinwandel et al. to minimize loss of solvent due to evaporation, as suggested by Sirkar et al. '103 in col. 2, lines 21-42.

Allowable Subject Matter

8. Claims 36, 37 and 39-46 are allowed.
9. Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M. Greene
Primary Examiner
Art Unit 1797

/Jason M. Greene/
1/17/09

jmg
January 17, 2009